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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/932,808	08/17/2001	Gregory Fx Iannacci	GFX-113	5862

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EXAMINER

LIVERSEDGE, JENNIFER L

ART UNIT	PAPER NUMBER
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3692

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/04/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/932,808

Applicant(s)

IANNACCI, GREGORY FX

Examiner

Jennifer Liversedge

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 January 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

This Office Action is responsive to Applicant's amendment and request for reconsideration of application 09/932,808 filed on January 17, 2007.

The amendment contains amended claims: 1, 3, 5, 7, 12-16, 18-20, 25-27.

The amendment contains previously presented claims: 2, 4, 6, 8-11, 17, 21-24.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-24 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The negative limitation, as submitted in the amended claims, of "other than a preferred charge card choice", is not supported in the specification.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-24 are rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant(s) regard as their invention. Evidence that claims 1-24 fail(s) to correspond in scope with that which applicant(s) regard as the invention can be found in the reply filed January 17, 2007. In that paper, applicant has stated such mechanisms as "a novel compliance matching paradigm to produce settlements", and the "solutions that use any available account and settlement means in any order to achieve the user's preferred benefits", among others, and this statement indicates that the invention is different from what is defined in the claim(s) because there is no mechanism for carrying out the matching to produce settlement or using any available means to achieve user's preferred benefits as the claims are currently written.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-2, 4, 6-11 and 13-24 are rejected under 35 U.S.C. 102(e) as being anticipated by Patent No. 5,477,040 to Lalonde (further referred to as Lalonde).

Regarding claim 1, Lalonde discloses an incentive-controlled method for use in the trading and/or acquisition of user-declared preferred benefits (other than a preferred

charge card choice), said method employing computer means having data storage means and network communications means (Figure 1) and comprising the steps of:

(a) receiving a request to produce an incentive-controlled settlement solution for an identified user having declared preferred and ranked benefit preferences (other than a preferred charge card choice) (column 1, lines 8-20; column 3, lines 3-18 and lines 20-37; column 4, lines 8-19 and lines 56-61; column 6, lines 20-58; column 9, lines 31-40);

(b) conducting an electronic search to identify any of said user's declared preferred benefits that are pertinent and may be obtainable in association with said request (column 3, lines 10-18 and lines 20-37; column 4, lines 8-19 and lines 56-61; column 6, lines 20-58; column 9, lines 31-40); and

(c) categorizing any benefits this identified in accordance with said user's declared preferred and ranked benefit preferences (column 2, lines 38-43; column 3, lines 10-18 and lines 20-37; column 4, lines 8-19 and lines 56-61; column 6, lines 20-58; column 9, lines 31-40).

Regarding claim 2, Lalonde discloses the method comprising the further step of determining a settlement solution associated with at least one of said categorized benefits (column 2, lines 38-43; column 3, lines 10-18 and lines 20-37; column 4, lines 8-19 and lines 56-61; column 6, lines 20-58; column 9, lines 31-40).

Regarding claim 4, Lalonde discloses the method comprising the further steps of evaluating said categorized benefits and determining at least one of said categorized benefits as providing said user with the benefit of highest value to said user (column 2, lines 38-43; column 3, lines 10-18; column 9, lines 31-40; column 10, lines 19-30).

Regarding claim 6, Lalonde discloses the method wherein the step of evaluating said categorized benefits is undertaken by the user upon electronic disclosure of said categorized benefits to said user (column 4, lines 14-19; column 9, lines 31-40; column 10, lines 19-30).

Regarding claim 7, Lalonde discloses the method wherein said step of determining said benefit of highest value to said user is performed automatically without user intervention (column 1, lines 5-19; column 2, lines 38-43; column 3, lines 10-36; column 4, lines 14-19 and lines 56-61; column 6, lines 53-57; column 9, lines 31-40; column 10, lines 19-30).

Regarding claim 8, Lalonde disclosed the method further comprising the steps of:

(a) identifying at least one provider of said settlement solution (Figures 1, 5 and 6); and

(b) initiating and consummating a transaction with the provider, or plurality of providers, of said settlement solution (Figures 1, 5 and 6).

Regarding claim 9, Lalonde discloses the method further comprising the step of establishing such electronic and logical linkages as may be required to enable said user to process said settlement solution and to acquire said benefits associated with said solution (Figures 1, 5 and 6).

Regarding claim 10, Lalonde discloses the method further comprising the additional steps of obtaining such accounts and of satisfying such conditions as may be required to process said settlement solution and to acquire for said user the said benefits associated with said solution (Figures 1, 5, 6 and 7).

Regarding claim 11, Lalonde discloses the method wherein said step of determining a settlement solution comprises a selection by said user from among plurality of proposed settlement solutions transmitted electronically to said user (column 4, lines 14-19; column 9, lines 31-40; column 10, lines 19-30).

Regarding claim 13, Lalonde discloses the method further comprising the step of determining at least one incentive-controlled settlement solution to a payment transaction (column 2, lines 38-43; column 3, lines 10-18 and lines 20-37; column 4, lines 8-19 and lines 56-61; column 6, lines 20-58; column 9, lines 31-40).

Regarding claim 14, Lalonde discloses the method further comprising the step of electronically transmitting, to at least one payment service provider able to provide at least one of said identified benefits, such user information and such payment transaction information as said at least one payment service provider may require as conditions for authorizing payment of said payment transaction and issuing said at least one benefit to said user (Figures 1, 5, 6, 7 and 8).

Regarding claim 15, Lalonde discloses the method further comprising the step of electronically transmitting, to at least one benefit provider able to provide at least one of said identified benefits, such user information and such payment transaction information as said at least one benefit provider may require as conditions for issuing said at least one benefit to said user (Figures 1, 5, 6, 7 and 8).

Regarding claim 16, Lalonde discloses the method further comprising the step of determining at least one incentive-controlled settlement solution to a query from a user concerning a proposed acquisition of goods or services (column 2, lines 38-43; column 3, lines 10-18 and lines 20-37; column 4, lines 8-19 and lines 56-61; column 6, lines 20-58; column 9, lines 31-40).

Regarding claim 17, Lalonde discloses the method further comprising the step of electronically disclosing to said user said at least one settlement solution responsive to said query (column 4, lines 14-19; column 9, lines 31-40; column 10, lines 19-30; Figures 1, 5 and 6).

Regarding claim 18, Lalonde discloses the method further comprising the step of transmitting electronically a proposed acquisition query to at least one provider of goods or services, whereby said at least one provider is caused to commit electronically to the consummation of a transaction on terms providing for the issuance of a specified identified benefit, or plurality or benefits, to said user (column 1, lines 5-28; column 2, lines 58-63; column 3, lines 20-37; column 4, lines 56-61; column 6, lines 20-59; column 8, lines 1-8; Figures 1, 5, 6, 7 and 8).

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Regarding claim 19, Lalonde discloses the method further comprising the step of transmitting electronically a binding commitment from said user to consummate said provider-committed transaction on said specified benefit-issuance terms (Figures 1, 5, 6, 7 and 8).

Regarding claim 20, Lalonde discloses the method further comprising the step of determining at least one incentive-controlled settlement solution to a benefit exchange transaction between at least two identified users (column 1, lines 5-28; column 2, lines 58-63; column 3, lines 20-37; column 4, lines 56-61; column 6, lines 20-59; column 8, lines 1-8; Figures 1, 5, 6, 7 and 8).

Regarding claim 21, Lalonde discloses the method further comprising the step of electronically transmitting a benefit exchange solicitation from a first identified user to at least one other user (column 1, lines 5-28; column 2, lines 58-63; column 3, lines 20-37; column 4, lines 56-61; column 6, lines 20-59; column 8, lines 1-8; Figures 1, 5, 6, 7 and 8).

Regarding claim 22, Lalonde discloses the method further comprising the steps of:

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(a) said first user receiving electronically an affirmative response to said solicitation from at least one other user (column 1, lines 5-28; column 2, lines 58-63; column 3, lines 20-37; column 4, lines 56-61; column 6, lines 20-59; column 8, lines 1-8; Figures 1, 5, 6, 7 and 8);

(b) transmitting at least one proposed benefit exchange solution between said users (column 1, lines 5-28; column 2, lines 58-63; column 3, lines 20-37; column 4, lines 56-61; column 6, lines 20-59; column 8, lines 1-8; Figures 1, 5, 6, 7 and 8); and

(c) consummating a benefit exchange transaction between said first user and at least one other user (Figures 1, 5, 6, 7 and 8).

Regarding claim 23, Lalonde discloses the method wherein said transaction is consummated employing preprogrammed instructions enabling its consummation without the transaction-specific participation of at least one user party to said transaction (column 1, lines 5-19; column 2, lines 38-43; column 3, lines 10-36; column 4, lines 14-19 and lines 56-61; column 6, lines 53-57; column 9, lines 31-40; column 10, lines 19-30).

Regarding claim 24, Lalonde discloses the method wherein said transaction is consummated employing user intervention and instructions enabling its consummation

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with the transaction-specific participation of at least one user party to said transaction (column 4, lines 14-19; column 9, lines 31-40; column 10, lines 19-30).

Claims 25-27 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,945,653 to Walker et al. (further referred to as Walker).

Regarding claim 25, Walker discloses an apparatus for creating and employing incentive-controlled settlement solutions based on user-declared preferred benefits by establishing and executing functions that review and determine objects, accounts, and conveyance mechanisms to consummate transactions (Figures 2, 5 and 7A-7C; column 3, lines 42-51; column 4, lines 12-40; column 8, lines 33-57), said apparatus comprising:

- (a) a processor (Figure 2; column 11, lines 29-65);
- (b) an input device connected to said processor (Figure 2; column 11, lines 29-65);
- (c) an output device connected to said processor (Figure 2; column 11, lines 29-65);
- (d) a clock device connected to said processor (Figure 2; column 11, lines 29-65);
- (e) a logic and control device connected to said processor (Figures 2 and 7A-7C; column 11, lines 29-65);

(f) a memory connected to said processor storing programs to control the operation of said processor (Figure 2; column 11, lines 29-65);

(g) a communication device connected to said processor (Figure 2; column 11, lines 29-65);

(h) a data storage device connected to said processor (Figure 2; column 11, lines 29-65);

(i) the processor operative with the program in memory to:

i. record data of users, benefits, settlement solutions, and transactions (column 11, lines 36-40; Figure 2);

ii. record the user entry and ranking of at least one declared benefit preference (column 11, lines 36-40; Figure 2);

iii. receive requests to process transactions (column 5, lines 28-35; column 18, lines 16-22);

iv. enable information to be available to users (column 16, lines 44-50; column 18, lines 45-48);

v. conduct automatic evaluations and rankings of at least one contemplated benefit opportunity based on a user's declared benefit preferences (column 3, lines 10-18 and lines 20-37; column 4, lines 8-19 and lines 56-61; column 6, lines 20-58; column 9, lines 31-40);

vi. produce incentive-controlled settlement solutions (column 19, lines 44-56);

vii. conduct automatic evaluations and rankings of at least one settlement solution based on a user's declared benefit preferences (column 2, lines 38-43; column 3, lines 10-18 and lines 20-37; column 4, lines 8-19 and lines 56-61; column 6, lines 20-58; column 9, lines 31-40);

viii. process settlement solutions with and without user intervention (column 15, lines 62-67; column 18, lines 43-48; column 19, lines 44-56);

ix. transmit information to users electronically (Figure 9; column 18, lines 45-48);

x. consummate transactions (Figures 7A-7C; Figures 8A-8B); and

xi. receive, record, evaluate, and store user information and transaction activity (Figures 7A-7C; Figures 8A-8B).

Regarding claims 26 and 27, Walker discloses an apparatus and storage medium device for creating and employing incentive-controlled settlement solutions based on user-declared preferred benefits by establishing and executing functions that review and determine objects, accounts, and conveyance mechanisms to consummate transactions (Figures 2, 5 and 7A-7C; column 3, lines 42-51; column 4, lines 12-40; column 8, lines 33-57), said apparatus comprising:

(a) means for recording data of users, benefits, settlement solutions, and transactions (column 11, lines 36-40; Figure 2);

(b) means for recording the user entry and ranking of at least one declared benefit preference (column 11, lines 36-40; Figure 2);

(c) means for receiving requests to process transactions (column 5, lines 28-35; column 18, lines 16-22);

(d) means for enabling user access to information (column 16, lines 44-50; column 18, lines 45-48);

(e) means for conducting automatic evaluations and rankings of at least one contemplated benefit opportunity based on a user's declared benefit preferences (column 3, lines 10-18 and lines 20-37; column 4, lines 8-19 and lines 56-61; column 6, lines 20-58; column 9, lines 31-40);

(f) means for producing incentive-controlled settlement solutions (column 19, lines 44-56);

(g) means for conducting automatic evaluations and rankings of at least one settlement solution based on a user's declared benefit preferences (column 2, lines 38-43; column 3, lines 10-18 and lines 20-37; column 4, lines 8-19 and lines 56-61; column 6, lines 20-58; column 9, lines 31-40);

(h) means for processing settlement solutions with and without user intervention (column 15, lines 62-67; column 18, lines 43-48; column 19, lines 44-56);

(i) means for transmitting information to users electronically (Figure 9; column 18, lines 45-48);

(j) means for consummating transactions (Figures 7A-7C; Figures 8A-8B); and

(k) means for receiving, recording, evaluating, and storing user information and transaction activity (Figures 7A-7C; Figures 8A-8B).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lalonde and further in view of Introduction to Industrial and Systems Engineering by Turner et al., 1993 (further referred to as Turner).

Regarding claim 3, Lalonde discloses wherein user preferences are employed in determining said settlement solution (column 2, lines 38-43; column 3, lines 10-18 and lines 20-37; column 4, lines 8-19 and lines 56-61; column 6, lines 20-58; column 9, lines 31-40). Lalonde does not disclose a Pareto optimal function. However, Turner discloses a Pareto optimal function or multivariable data modeling (page 228). It would be obvious to one of ordinary skill in the art to modify the card selection method as

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disclosed by Lalonde to adapt the teaching of a Pareto optimal function or multivariable data modeling as disclosed by Turner. The motivation would be that a Pareto analysis is performed when issues of prioritization are under consideration and for the card selection process, it would be necessary to prioritize the user preferences in order to make a decision as to which card to select.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lalonde as applied to claim 4 above, and further in view of Patent No. 5,945,653 to Walker et al. (further referred to as Walker).

Regarding claim 5, Lalonde does not disclose the method wherein said benefit of highest value to said user is obtained from the combination of a plurality of said user declared preferred categorized benefits. However, Walker discloses the method wherein said benefit of highest value to said user is obtained from the combination of a plurality of said user declared preferred categorized benefits (column 4, lines 34-40; column 10, lines 13-21; column 11, lines 3-20). It would be obvious to one of ordinary skill in the art to modify the card selection method as disclosed by Lalonde to adapt the teaching of applying a combination of benefits in order to obtain the highest value to a user as disclosed by Walker. The motivation would be that given a user has a plurality of cards, options yielding the highest return may include a combination of promotions or offers and the most effective system would provide the means by which a user would "cash in" all available options, such as the use of a manufactures coupon as well as

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"double" or "triple" coupons offered by a particular store, such that value would be maximized using all available options.

Claim 12 rejected under 35 U.S.C. 103(a) as being unpatentable over Lalonde. Lalonde does not specifically disclose the method further comprising the additional steps of aggregating a plurality of requests involving a plurality of identified users and of operating on such aggregated declared preferred benefits to effect an enhancement in the potential value of at least one of said identified benefits to at least one of said identified users. However, Examiner takes Official Notice that it is old and well known for companies and organizations to hear customers' requests and to consider modifications to policies and procedures of all varieties in response to said requests, the motivation being that in the name of good will and customer service, companies and organizations are willing to hear, and respond if possible, to customer requests, particularly when the same request is received from a number of sources. It shows a consensus amongst customers that a policy or procedure of some sort should be modified. Further, the gathering of data based on consumer's shopping and browsing habits, such as is the case in internet shopping and browsing, provides organizations with information on consumers' interests, provides feedback on which types of advertisements are effective in causing consumers to "click through" advertising banners, etc. This type of data mining is old and well known in the art.

Response to Arguments

Examiner invites and encourages Applicant to schedule a telephonic interview with the Examiner to discuss the claims in the present application to further prosecution most efficiently.

In response to the Applicant's arguments, Examiner cites the Lalonde (US Patent No. 5,477,040) and Walker (5,945,653) references as reading on the claims as written. The first and second paragraph 35 U.S.C. 112 rejections are in response to the amendments as filed January 17, 2007. First, applicant creates a negative limitation, namely, "other than a preferred charge card choice" and this limitation is not supported in the specification. The specification of the present application specifically refers to the use of credit cards throughout the specification but not specifically to a choice other than a preferred charge card choice.

Secondly regarding 35 U.S.C. 112 rejections, Examiner cites that the current application fails to set forth the subject matter which applicant(s) regard as their invention. Examiner understands from the specification and the arguments filed that the intent of the invention is to create a system by which users input preferences of benefits or incentives to be obtained, and where the present invention canvasses available means of conducting a transaction in order to obtain those benefits or incentives for the user, wherein a comparison is made amongst incentives available and incentives as ranked by users, including the securing of a transaction mechanism if the user does not currently have access to that particular means. However, the claims as written do not reflect this.

Lalonde discloses a point of charge card selection means, where the selection is a charge card. Examiner notes that the card is selected only as a settlement solution, as disclosed by claim 1. The consumer has actually selected whether they wish to receive a particular interest rate, or issuer promotions, or credit limit considerations, etc. These are the characteristics the consumer is choosing, which thereby results in the use of a particular card as means of settlement solution; but it is benefit or incentive that drives the ranking of the consumer's preferences, not the charge card itself.

Applicant argues that the current invention operates in which employed are "solutions that use any available account and settlement means in any order to achieve the user's preferred benefits". However, this concept and corresponding language is not reflected in the claims as they are currently written.

Applicant argues that the current invention operates to automatically subscribe to and activate settlement means to achieve a user's preferred benefit. However, this concept and corresponding language is not reflected in the claims as they are currently written.

Applicant argues that the current invention functions not only at the time of point of sale but also before and/or after a sale. However, this concept and corresponding language is not reflected in the claims as they are currently written.

Applicant argues that the current invention uses any Pareto function or multivariable data modeling, and that the combination of Turner with Lalonde is improper. Examiner argues that the use of Pareto functions are old and well known and used in instances in which items or categories are ranked and set forth in a comparative

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manner. This is a proper combination as the use of Pareto analysis is a standard mathematical procedure used across a multitude of disciplines for the portrayal of data in a categorized format.

Applicant argues that the present invention is never influenced by a benefit unless the benefit has been identified as relevant to the declared preferred benefit objectives of the user. Lalonde provides a system whereby only those benefits that the user is interested in are considered. Again, the claim language of the current application does not capture a system by which users input preferences of benefits or incentives to be obtained, and where the present invention canvasses available means of conducting a transaction in order to obtain those benefits or incentives for the user, wherein a comparison is made amongst incentives available and incentives as ranked by users, including the securing of a transaction mechanism if the user does not currently have access to that particular means.

Applicant argues that Walker fails to show identification of a user's preferred benefit and that the object of Walker is to provide a user manual control system. Walker discloses the use of functions to aid in the process of conducting a point of sale transaction such that incentives can be taken advantage of, thus a preference of the user, by both manual and automatic control means.

Applicant argues that Lanlonde does not disclose allowing splitting of a charge transaction amongst several charge cards. However, this concept and corresponding language is not reflected in the claims as they are currently written.

Arguments regarding the gathering of consumer preferences in terms of "observing" declared characteristics in order to formulate awards, compared to a system of users making their preferences known has been addressed in the rejection above. However, the Examiner's argument in the current rejection is that the gathering of data based on consumer's shopping and browsing habits, such as is the case in internet shopping and browsing, provides organizations with information on consumers' interests, provides feedback on which types of advertisings are effective in causing consumers to "click through" advertising banners, etc. This type of data mining is old and well known in the art.

Again, Examiner invites and encourages Applicant to schedule a telephonic interview with the Examiner to discuss the claims in the present application to further prosecution most efficiently prior to submission of further amendments.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication should be directed to Jennifer Liversedge whose telephone number is 571-272-3167. The examiner can normally be reached on Monday – Friday, 8:30 – 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached at 571-272-6777. The fax number for the organization where the application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jennifer Liversedge

Examiner

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RICHARD E. CHILCOT, JR.
SUPERVISOR BY PATENT EXAMINER